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10/30/2003

Siong Lee Lim

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EXAMINER

PHAM, MINH CHAU THI

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIONG LEE LIM and CHEE YIN CHAN

Appeal 2010-000612
Application 10/696,879
Technology Center 1700

Decided: June 04, 2010

Before EDWARD C. KIMLIN, CHUNG K. PAK, and
MARK NAGUMO, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-10 and 12-22.
We have jurisdiction under 35 U.S.C. § 6(b).

Claims 1 and 20 are illustrative:

1. A data storage system comprising:

an enclosure configured to house components of the data storage system, the enclosure having an outer surface and an inner surface;

an aperture extending between the outer surface and the inner surface of the enclosure, wherein the aperture has a larger cross-section adjacent the outer surface than adjacent the inner surface and wherein a diameter of the aperture continuously tapers from the outer surface to the inner surface of the enclosure; and

a filter disposed within the aperture.

20. The method of claim 19, wherein depositing the filter further comprises:

mounting a seal layer to the outer surface of the tray and a portion of the filter, wherein the seal layer includes a liner and a seal; and

fastening the liner to the tray with a fastener to prevent the seal from adhering to the tray when the filter is removed from the tray.

The Examiner relies upon the following reference as evidence of obviousness (Ans. 2):

Crowder

6,214,070 B1

Apr. 10, 2001

Appellants' claimed invention is directed to a data storage system and a method of removing contaminants from air entering a data storage system. The system comprises an enclosure having outer and inner surfaces and an aperture extending between the two surfaces of the enclosure. The aperture has a larger cross-section adjacent the outer surface than that adjacent the inner surface of the enclosure. The diameter of the aperture continuously tapers from the outer surface to the inner surface. A filter for removing the contaminants is disposed within the aperture.

Appealed claims 1-10 and 12-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crowder.

We have thoroughly reviewed the respective positions advanced by Appellants and the Examiner. In so doing, we find ourselves in agreement with the Examiner that the subject matter of claims 1-10, 12-19 and 22 would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the Examiner's rejection of these claims for essentially those reasons expressed in the Answer. However, we will not sustain the Examiner's rejection of claims 20 and 21.

There is no dispute that Crowder, like Appellants, discloses a data storage system comprising an enclosure configured to house components of the system, which enclosure has an aperture extending between the outer and inner surfaces of the enclosure and wherein the diameter of the aperture continuously tapers from the outer surface to the inner surface. Also, like Appellants' data storage system, the system of Crowder has a filter disposed within the aperture. As recognized by the Examiner, although the aperture of Crowder tapers from a larger cross-section to a smaller cross-section between the outer and inner surfaces of the enclosure, the taper of Crowder's aperture is not continuous, as presently claimed. However, it is well settled that it is an obvious matter of design choice to change the general shape or size of a known element in the absence of a disclosed non-obvious advantage associated with the change. *Gardner vs. TEC Systems Inc.*, 725 F.2d 1338, 1349-50 (Fed. Cir. 1984); *In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975); *In re Dailey*, 357 F.2d 669, 672 (CCPA 1966). In the present case, Appellants have not set forth any adequate reason for why the claimed

continuous taper of the aperture provides a significant advantage over the non-continuous taper of Crowder's aperture that would not have been obvious to a person having ordinary skill in the art. Appellants submit that "[a] continuously tapered aperture in an enclosure supports the filter along its entire periphery resulting in a stably placed filter as well as provides repeatable accuracy in positioning of the filter" (Br. 8, last sentence). However, Appellants have not explained why the stated advantages do not also accrue to the aperture of Crowder. Nor have Appellants presented any objective evidence which provides a side-by-side comparison between apertures within the scope of the appealed claims and the aperture fairly taught by Crowder. It is axiomatic that counsel's arguments in the Brief are no substitute for objective evidence.

Appellants also maintain that Crowder fails to teach or suggest a label adhered to the outer surface of the enclosure and the seal, as recited in claim 8. However, Appellants have not contested the Examiner's finding that the data storage system of Crowder includes a seal and a label adhered to its outer surface. Accordingly, we agree with the Examiner that it would have been a matter of obvious design choice to place the label on any particular area of the enclosure's outer surface.

We are also not persuaded by Appellants' argument that Crowder does not teach or suggest transferring the filter from a supplier to an assembler in a tray whereupon the filter is removed from the tray and placed in the aperture of the enclosure. The recited term "tray", as broadly construed, encompasses any substrate for supporting the filter and we perceive nothing non-obvious in supplying the filter in or on a carrier substrate before it is positioned in the aperture.

The rejection of claims 20 and 21 is another matter. These claims require mounting a seal layer to the outer surface of the tray and a portion of the filter, wherein the seal layer includes a liner and a seal, and fastening the liner to the tray with a fastener, etc. The Examiner, however, has cited no teaching or suggestion in Crowder in support of the conclusion that the claimed limitations would have been obvious to one of ordinary skill in the art. Indeed, the Examiner has not addressed these limitations in the Answer. As a result, we are constrained to reverse the Examiner's § 103 rejection of claims 20 and 21.

In conclusion, based on the foregoing, the Examiner's decision rejecting claims 1-10, 12-19, and 22 is affirmed. The Examiner's rejection of claims 20 and 21 is reversed. Accordingly, the Examiner's decision rejecting the appealed claims is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2008).

AFFIRMED-IN-PART

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